

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert R. Parsons : Docket: #0013
Application No.: 10/811,616 : Examiner: Stroder, Carrie A.
Filing Date: March 29, 2004 : Art Unit: 3689
Confirmation No: 2720 : Customer No. 43,699
Title: **PROCESS FOR REGISTERING AND TRADEMARKING
DOMAIN NAMES**

REPLY BRIEF

Appellant hereby incorporates into this Reply Brief and reserves and reiterates all arguments made in the Appeal Brief. Appellant, in order to make this Reply Brief as concise as possible, will only address the Examiner's *Response to Argument* on pages 11-14 as all other Examiner arguments appear to remain the same.

I. 1. Prior art does not teach "Entrepreneur" as limited by other limitations.

The Examiner's Answer on page 11 states:

Applicant seems to be arguing that the word "Entrepreneur" as used in the claims is defined by other limitations in the claim. Examiner respectfully disagrees. None of the limitations of the claim define the word "entrepreneur." (emphasis added)

Applicant respectfully disagrees that a word in a claim (such as "Entrepreneur") cannot be limited "by other limitations in the claim." It is accepted that Applicants can act as their own lexicographer. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Contrary to the Examiner's assertion, if Applicants can define a word in the written description (as found in *Process Control Corp.*), then surely Applicants can limit a word in a claim using "other limitations in the claim."

Claims 1, 7, 13 and 19 are reproduced below for easy reference:

1. A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of:
 - A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;
 - B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site; and
 - C) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet. (emphasis added)

7. A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of:

- A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;
- B) the Facilitator's web site offering hosting services on a hosting server for an Entrepreneur's web site at an Internet protocol address associated with a domain name registered with a Registry and having a label and a top-level domain; and
- C) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet. (emphasis added)

13. A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of:

- A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;
- B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site;
- C) the Facilitator's web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet protocol address associated with the registered domain name; and
- D) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet. (emphasis added)

19. A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of:

- A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;
- B) the Facilitator's web site receiving information regarding the Entrepreneur that has accessed the Facilitator's web site;
- C) the Facilitator's web site storing the information regarding the Entrepreneur in a memory location accessible by the Facilitator's web site;
- D) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name using at least some of the stored information regarding the Entrepreneur; and
- E) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office using at least some of the stored information regarding the Entrepreneur, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet. (emphasis added)

The prior Go Daddy service and Chauchard do not teach an "Entrepreneur" that trademarks a domain name or label of the domain name (claims 1, 7, 13 and 19) AND either registers the domain name (claims 1, 13 and 19) or receives an offer for hosting services (claims 7 and 13). Since an "Entrepreneur," as limited by other limitations in the claims, is not taught by the prior art, the claimed invention is not obvious. Merely showing the nouns and verbs of a claim, such as "Entrepreneur," were known in the prior art does not consider all the words in the claim. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, Applicant respectfully requests the reversal of the Examiner's rejection.

2. **Prior art does not teach an Entrepreneur trademarking the domain name or the label [of a domain name] from a Facilitator's web site.**

The Examiner's Answer on page 12 states "Chauchard teaches assisting the entrepreneur in trademarking a name (see Abstract) via a computer connected to the internet." Applicant would like to clarify that Chauchard teaches using a local computer to prepare a trademark application (Chauchard [0001]). The local computer sends the trademark application to a remote computer, such as to a member of the Compagnie Nationale des Conseils en Propriete Industrielle for professional review (Chauchard [0023, 0037, 0042 and 140]). The trademark application may then be filed with the competent administrative department (Chauchard [0003]).

The Examiner's Answer on page 12 states "Go Daddy teaches using a facilitator's web site to offer services." Please note the Examiner does not allege the prior Go Daddy service teaches trademarking anything, let alone domain names.

The Examiner's Answer on page 12 states:

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with receiving hosting services for the website associated with the domain name.

Applicant respectfully disagrees that it would have been obvious to combine Go Daddy and Chauchard.

First, the motivation to combine alleged by the Examiner is actually stated in Applicant's written description on page 12, second full paragraph. The Examiner (other than making the unsupported statement that "it would have been obvious") has not shown where the motivation to combine comes from within the prior art.

Second, neither Go Daddy nor Chauchard teaches the limitation of a website assisting an Entrepreneur in trademarking anything, let alone a domain name. This limitation, in all the independent claims, is not taught by the prior art and thus the independent claims cannot be obvious without all the limitations being taught.

And third, the Examiner's Answer on page 12 admits "Chauchard does not teach using a website to offer services" (as recited in all the independent claims). In fact, Chauchard stresses the importance of the trademark application being sent to a remote computer, i.e. not a website.

to be reviewed by professionals (Chauchard [0006, 0008, 0013-0015, 0023 and 0028]). Thus, not only does Chauchard not teach using a website, Chauchard actually teaches away from using the claimed Facilitator's web site to perform trademark services because the trademark application would not be properly reviewed, according to Chauchard teachings, by professionals at a remote computer. If Chauchard teaches away from using a Facilitator's web site (the specific teaching used by the Examiner in making the obviousness rejection) in the prior Go Daddy service, then the combination of the prior Go Daddy service website would not have been obvious with Chauchard.

3. Prior art does not teach a "Facilitator's web site" that assists Entrepreneurs in preparing trademark applicants AND either registers domain names (claims 1, 13 and 19) or offers hosting services (claim 7).

The Examiner's Answer on page 12 states:

Applicant seems to be arguing that Examiner must provide prior art which provides a single web site which performs multiple claim limitations, or in other words, that Examiner cannot provide a rejection under 35 USC 103. Examiner respectfully disagrees. Examiner need not provide a single web site which performs all claimed limitations.

While Examiners are of course allowed to make obviousness type rejections, the problem with the Examiner's obvious rejection is that the Examiner has not shown a teaching for a website used to trademark domain names and thus cannot have shown a teaching for a Facilitator's web site that assists Entrepreneurs in preparing trademark applications AND either registers domain names (claims 1, 13 and 19) or offers hosting services (claim 7).

The Examiner appears to believe that by showing that "websites" were known; and that "trademarking" was known; and that "domain names" were known, that somehow teaches a website trademarking domain names as well as every other possible permutation and combination of those nouns and verbs. Merely showing the nouns and verbs in a claim were known, does not consider "all" the words in the claim or properly considers the claim as a whole. Rarely are individual words in a claim not already known in the art, that is why the relationships of the words and "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, Applicant respectfully submits that the Examiner, in merely showing the nouns and verbs were known, did not properly consider the relationships of the nouns and verbs or show that those relationships were known in the prior art.

II. It would not have been obvious to combine the prior Go Daddy service with Chauchard.

The Examiner's Answer on pages 13-14 explains why the Examiner believes the combination of the prior Go Daddy service and Chauchard are obvious. Applicant respectfully disagrees for the three reasons already expressed in section I. 2.

CONCLUSION

Appellant respectfully submits that the prior Go Daddy service and Chauchard do not teach all the claim limitations as explained above. Specifically, the prior Go Daddy service and Chauchard do not teach: 1) an "Entrepreneur," 2) trademarking a domain name or label from a Facilitator's web site, or 3) a "Facilitator's web site" as those terms are explicitly limited and described in independent claims 1, 7, 13 and 19.

In addition, Appellant respectfully submits that it would not have been obvious to combine the prior Go Daddy service and Chauchard as Chauchard teaches away from the use of a web site.

Appellant thus requests a decision by the Board reversing the rejections to claims 1-19 by the Examiner. Any questions regarding the earlier filed Appeal or this Reply should be directed to the undersigned attorney for Appellant at the telephone number or email address listed below.

Respectfully submitted,

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Date: 2/2/2011

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